

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) Group Art Unit: 2419
)
Stewart Frederick Bryant, et al.) Examiner: Anthony M. Sol
)
Application No. 10/620,866) Confirmation No.: 9132
)
Filed: July 15, 2003)
)
For: Method and Apparatus for Forwarding a)
Tunneled Packet in a Data Communications)
Network)

Mail Stop Amendment

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY TO OFFICE ACTION

Sir:

In reply to the Office Action mailed on May 13, 2009, for which the shortened statutory period for reply ends on August 13, 2009, applicants respectfully request reconsideration in light of the following remarks.

I. “OMITTED ELEMENT” ISSUE

Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly incomplete for omitting essential elements. (Office Action, page 2) The Office Action asserted that a gap exists between the elements of Claims 1, 9-10 and 18 because the claims do not recite the step of “the forwarding node (Rn-1) is given permission by the tunnel end point (Rn) or by manual configuration to remove the header and forward the payload to the tunnel end point,” or the step of “the forwarding node is notified by a routing protocol of the identity of a neighbor node as the tunnel end point.”. (Office Action, page 2) This rejection is respectfully traversed.

The Office Action relies on MPEP section 2172.01:

“Unclaimed Essential Matter: A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of

record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP Section 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements **described by the applicant(s) as necessary to practice the invention**. In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)."

(Emphasis added.) The MPEP section—which is merely advisory, as the USPTO has never adopted the MPEP in an administrative rulemaking—suggests two grounds for rejection: (1) a 35 U.S.C. §112 first paragraph (enablement) rejection for claims that omit essential matter, and (2) a §112 second paragraph rejection for claims that fail to interrelate essential elements. *Gentry Gallery Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998) (hereinafter GENTRY) addressed a third type of issue. GENTRY held invalid under 35 U.S.C. §112 first paragraph (written description) certain claims that did not recite the **location** of a claimed element, because the applicant had urged at numerous places outside the claims that the location of the element was essential to the invention.

None of these sources provide grounds for the rejection given in the present Office Action, which is a rejection under 35 U.S.C. §112, second paragraph for omitting essential elements. However, because the Office Action makes reference to “omitted essential elements,” this response assumes that the rejection of Claims 1-18 was meant to be based on 35 U.S.C. §112 first paragraph (enablement).

A. The “Omitted Essential Elements” Cases Require an Explicit Statement That an Element is Required

The Applicant, not the USPTO, has the right and responsibility to specify what the Applicant believes to be the metes and bounds of the invention. Generally, the claims communicate the metes and bounds of the invention to the USPTO and to the public:

“...when the first paragraph speaks of “the invention,” it can only be referring to that invention which the applicant wishes to have protected by the patent grant, i.e., the *claimed* invention. For this reason the claims must be analyzed first in order to determine exactly what subject matter they encompass. **The subject matter there set out must be presumed, in the absence of evidence to the contrary, to be that “which the applicant regards as his invention.”**

In re Moore and Janoski, 169 USPQ 236, 238, (CCPA 1971) (emphasis added). In some past cases, patent applicants have participated in the unwise practice of rigidly and emphatically stating, at locations other than in the claims, the metes and bounds of their invention. When such statements have been made outside the claims, courts have not allowed the applicants to obtain claims that contradict the statements.

Thus, the “omitted essential element” ground of rejection hinges on the existence of **statements made by the applicant that prove that what is recited in the claims is not the invention**. As stated in the MPEP, *supra*, “essential matter may include missing elements, steps or necessary structural cooperative relationships of elements **described by the applicant(s) as necessary to practice the invention.**” MAYHEW involved statements in the Specification that the functions of certain claimed elements **were only made possible** by the existence of another element that was omitted from the claims.¹ In GENTRY, the Specification contained statements that **the only possible location** for a claimed element was at a particular location, where the

¹ “Although appellant now strenuously argues that the cooling bath is optional, his specification not only fails to support this contention, but leads us, as it did the examiner and board, to believe that both it and its location are essential.” MAYHEW at 358.

claims failed to recite that the claimed element was at that particular location.²

The “omitted essential element” ground of rejection is similar to prosecution history estoppel in that it prevents an applicant from making assertions that contradict previously-made statements. In particular, it prevents an applicant from asserting, implicitly through the claims, that the invention has one set of metes and bounds, when the applicant has already clearly stated elsewhere that the invention necessarily has a different set of metes and bounds.

B. The “Omitted Essential Elements” Rejection is Unsupported under Applicable Law Because Applicants Have Made No Statements That an Element is Required

The present rejection of Claims 1-18 erroneously applies the law of “omitted essential elements.” Applicants have not made any statements whatsoever to indicate that the invention recited in Claims 1-18 is not what the applicant considers to be the invention. Nor has the applicant stated that the elements recited in Claims 1-18 would be impossible to implement in the absence of elements that are not recited in Claims 1-18. Rather, for example, it is entirely possible to implement the elements recited in Claims 1-18 without also giving permission by the tunnel end point (Rn) or by manual configuration to remove the header and forward the payload to the tunnel end point.

Further, the Office Action fails to identify any statement in the Specification, or made by the applicants elsewhere, that even remotely implies that the invention recited in Claims 1-18 could not be practiced in the absence of the alleged unclaimed elements. In fact, paragraph [33] of the applicants’ specification states that “signaling of giving such permission … at the neighboring node… is optional.” Therefore, any attempt to force such unclaimed elements into Claims 1-18 would unduly narrow the claims.

For the reasons given above, Applicants respectfully submit that Claims 1-18 are not missing any elements that are essential to practicing the invention that is recited in Claims 1-18.

² “In this case, the original disclosure clearly identifies the console as the only possible location for the controls.” GENTRY at 1503.

Further, the metes and bounds of the invention set forth in Claims 1-18 do not contradict any statements about the invention elsewhere. Rather, the applicants go to great effort to refrain from making any statements about the invention (as opposed to embodiments thereof) outside the claims themselves, since at best such statements are innocuously redundant with the claims, and at worst they are confusingly contradictory with the claims.

Therefore, reconsideration and removal of the rejection to Claims 1-18 is respectfully requested.

II. CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested.

If any applicable fee is missing or insufficient, the Commissioner is authorized throughout the pendency of this application to charge any applicable fee to our Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: August 6, 2009

/MalgorzataAKulczycka#50496/

Malgorzata A. Kulczycka
Reg. No. 50,496

2055 Gateway Place, Suite 550
San Jose, California 95110
Telephone: (408) 414-1228
Facsimile: (408) 414-1076